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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,519	02/04/2004	Yoshimichi Kudo	500.43478X00	1742
20457	7590	09/05/2007		
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			EXAMINER HAILU, TESHOME	
			ART UNIT 2109	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/770,519

Applicant(s)

KUDO ET AL.

Examiner

Teshome Hailu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/01/2006 and 02/04/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-12 are pending.

**Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-11 of copending Application No. 10/846,558. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12 of the instant application substantially recite the limitations of claims 1-11 of cited US application.

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Therefore, it would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the invention as claimed in the present application by adding a predetermined command request. Since an omission and addition of a cited limitation would have not changed the process according to which the method and system as claimed. Therefore, the use of adding a predetermined command request on the present invention would be an obvious variation in the art for the purpose of achieving the same end results.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwano; US pub. 2003/0226011, and further in view of Gerdes; US pub. 2003/0046541.

As per claim 1, Kuwano discloses.

- authenticating means for **receiving an authentication request from said content receiving device and authenticating said authentication request, and issuing in return an authentication request to said content receiving device**; (Abstract, line 12-15, "*the Consumer 40 issues a device authentication request command to the Producer 30 (Step 219) and they perform mutual device authentication and exchange of keys*").

- **encrypting means for generating key information by key information generated based on information obtained by performing an authentication process by said authenticating means, and carrying out an encryption process of a content to be transmitted to said content receiving device, by using said key information**; (page 2, paragraph 19, "*The Source 130 encrypts an encryption key*").

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for encrypting the content **using the calculated authentication key** when the calculation of the authentication key is terminated (Step 124) and **sends the encrypted key to the Sink 140**". Where the sink is a receiving side.

- **timer means for measuring a time from transmission of an authentication request to said content receiving device or a time from transmission of a response to said authentication request from said content receiving device until arrival of acknowledgement of receipt from said content receiving device**, (page 5-6, paragraph 79, "the Consumer 40 issues a device authentication request command to the Producer 30 (Step 219). The Producer 30 then can tell whether the Consumer 40 corresponds to a DTCP method or not **by starting up a timer to measure the time for receiving the device authentication request command** from the Consumer 40 after the Asynchronous Connection is established").

Kuwano does not explicitly disclose, a network communication. On the other hand, the same field of endeavor, Gerdes teaches the above limitation as:

- **network communication process means for transmitting and receiving data via a network**; send-content generating means for **supplying said network communication device with a content to be transmitted to a content receiving device connected via said network**; (page 5, paragraph 48, "The exchange of information can be **achieved over a fixed network like the Internet or a fixed telephone network like the Public Switched Telephone Network (PSTN)** or the Integrated Services Digital Network (ISDN) or wireless connections provided")

- Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to modify the teaching of Kuwano and include the network communication using the teaching of Gerdes. The modification would be obvious because one of ordinary skill in the art would be motivated to add a network communication to the system for having a better and wide means of communication that include both wireless and wired connection.

Kuwano does not explicitly disclose, measured result by a timer means. On the other hand, the same field of endeavor, Gerdes teaches the above limitation as:

- wherein when a **measured result by said timer means is larger than a predetermined value, the content is not transmitted to said content receiving device.** (Page 2, paragraph 13, "The authentication server performs an analysis of the service authentication confirmation, e.g. it is checked if the request for service authentication has been correctly acknowledged by the authentication device or if **the service authentication confirmation is received within a pre-defined time limit after issuing the request for service authentication. If the analysis fails, the authentication server may repeat the transmission of a request for service authentication or may terminate the authentication procedure**").

- Therefore, It would have been obvious to one of ordinary skill in the art, at the time of invention was made, to modify the teaching of kuwano and include the measure result by a timer means using the teaching of Gerdes. The modification would be obvious because one of ordinary skill in the art would be motivated to add a way of knowing authentication confirmation using a time limit for a better **security and prevents replay attacks** (page 3, paragraph 21).

Claim 2 is rejected under the same reason **set forth in rejection of claim 1:**

Claim 3 is rejected under the same reason **set forth in rejection of claim 1:**

As per claim 4, Kuwano discloses

- for **receiving an authentication request from said content receiving device and making a pass/failure decision on authentication of said authentication request, and issuing in return an authentication request to said content receiving device;** (page 2, paragraph 19, "**firstly a Sink 140, the receiving side, issues a device authentication request to a Source 130, the sending side (Step 121). In this case, the Sink 140 sends a parameter of the receiving side towards the Source 130. The Source 130 sends a parameter of the sending side to the Sink 140 when the received**

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*parameter* is **correct**. On the contrary, the Source 130 sends a notification which aims at rejecting the data transmission when the received parameter is **not correct**").

- **timer means for measuring a time** from transmission of a response to the **authentication request from said content receiving device until arrival of acknowledgement of receipt**, (page 5-6, paragraph 79, "the Consumer 40 issues a device authentication request command to the Producer 30 (Step 219). The Producer 30 then can tell whether the Consumer 40 corresponds to a DTCP method or not **by starting up a timer to measure the time for receiving the device authentication request command** from the Consumer 40 after the Asynchronous Connection is established").

Kuwano dose not explicitly discloses, a network communication. On the other hand, the same field of endeavor, Gerdes teaches the above limitation as:

- A content transmitting device comprising: authenticating means, when transmitting a content to a content receiving device connected via a network (page 5, paragraph 48, "The exchange of information can be **achieved over a fixed network like the Internet or a fixed telephone network like the Public Switched Telephone Network (PSTN)** or the Integrated Services Digital Network (ISDN) or wireless connections provided")

- Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to modify the teaching of Kuwano and include the network communication using the teaching of Gerdes. The modification would be obvious because one of ordinary skill in the art would be motivated to add a network communication to the system for having a better and wide means of communication that include both wireless and wired connection.

Kuwano dose not explicitly discloses, measured result by a timer means. On the other hand, the same field of endeavor, Gerdes teaches the above limitation as:

- **wherein when the measured result by said timer means is larger than a predetermined value, said content is not transmitted to said content receiving device**. (Page 2, paragraph 13, "The authentication server performs an analysis of the service authentication confirmation, e.g. it is checked if

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the request for service authentication has been correctly acknowledged by the authentication device or if *the service authentication confirmation is received within a pre-defined time limit after issuing the request for service authentication. If the analysis fails, the authentication server may repeat the transmission of a request for service authentication or may terminate the authentication procedure*").

- Therefore, It would have been obvious to one of ordinary skill in the art, at the time of invention was made, to modify the teaching of kuwano and include the measure result by a timer means using the teaching of Gerdes. The modification would be obvious because one of ordinary skill in the art would be motivated to add a way of knowing authentication confirmation using a time limit for a better **security and prevents replay attacks** (page 3, paragraph21).

Claim 5 is rejected under the same reason set forth in rejection of claim 1 and further Kuwano teaches:

- authenticating means for issuing an authentication request to said content transmitting device and making a **pass/failure decision on authentication of the authentication request received from said content transmitting device**; (page 2, paragraph 19, "*firstly a Sink 140, the receiving side, issues a device authentication request to a Source 130, the sending side (Step 121). In this case, the Sink 140 sends a parameter of the receiving side towards the Source 130. The Source 130 sends a parameter of the sending side to the Sink 140 when the received parameter is correct.* On the contrary, the Source 130 sends a notification which aims at rejecting the data transmission when the received parameter is **not correct**"). According to Kuwano, the decision on authentication is made in source (sending) side but the result and purpose is the same as the invention.

- **decrypting means** for generating key information by key information generated **based on information obtained by performing an authentication process by said authenticating means, and performing a decryption process of a content from said content transmitting device by using said key information**; (page 2, paragraph 19, "*The side of the Sink 140 decrypts the received encryption key based on the calculated authentication key* (Step 127). The Source 130 encrypts the content using



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the encryption key and sends the encrypted content (Step 129) *whereas the Sink 140 decrypts the received encrypted content*"). Where the sink is a receiving side.

Claim 6 is rejected under the same reason *set forth in rejection of claim 2:*

Claim 7 is rejected under the same reason *set forth in rejection of claims 1 and 2:*

Claim 8 is rejected under the same reason *set forth in rejection of claim 3:*

Claim 9 is rejected under the same reason *set forth in rejection of claim 3:*

Claims 10 and 11 is rejected under the same reason *set forth in rejection of claim 1:*

Claim 12 is rejected under the same reason *set forth in rejection of claims 1 and 5:*

### ***Conclusion***

6. The prior art made or record and not relied upon is considered pertinent to applicant's disclosure  
TITLE: Content distribution system, content distribution method, information processing apparatus, and program providing medium, US Pub. No. 20020027992.

TITLE: System and method for distributing digital content in a common carrier environment, US Pub. No. 20020059614.

TITLE: Content downloading system and method thereof, US Pub. No. 20030018751.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teshome Hailu whose telephone number is (571) 270-3159. The examiner can normally be reached on Mon-Fri 7:30a.m. to 5:00p.m. PST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chamili Das can be reached on (571) 272-3696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Teshome Hailu

Patent Examiner

TH

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JEAN M. CORRIELUS  
PRIMARY EXAMINER  
Art unit 2109  
Date: 9/4/07